

REMARKS

The present amendment is responsive to the Office Action mailed in the above-referenced case on April 24, 2002. Claims 1-4 and 17-22 are presented for examination. Claims 18, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuen et al. (U.S. 5,488,409), hereinafter Yuen. Claims 1-4, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen/Official Notice. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen in view of Ichinose (U.S. 4,612,569), hereinafter Ichinose.

Applicant has carefully studied the prior art cited and applied by the Examiner, and the Examiner's rejections and statements. Applicant herein presents arguments to more particularly point out the subject matter regarded as the invention, and to establish that the claims distinguish unarguably over the prior art. Applicant points out and argues the key limitations in the base claims that the Examiner appears to have misunderstood or overlooked in the rejections.

Applicant argues that Yuen teaches an invention that is entirely different from that claimed by applicant, for solving a completely different problem. Applicant's invention teaches a method and apparatus for automatically recording an incoming data stream in a circular manner, meaning that after a fixed time period of sequential recording, the recording apparatus will continue to record by overwriting the already recorded material in the same order as originally recorded, the oldest data being overwritten first. The net effect will be, at any moment in time, while the apparatus is recording, a recorded body of matter representing a time period prior to the present moment equal to the recorded time period represented by the magnitude of the memory apparatus being used.

Yuen teaches an apparatus and method for automatically monitoring the operations of a videocassette recorder, tracking which programs recorded on

various tapes are played. The VCR of Yuen monitors the selection habits of a viewer selecting from a plurality of videotapes, each videotape containing a plurality of programs. The invention of Yuen addresses the problem that publishers of videotapes presently have no method for determining the frequency of viewing of their videotapes.

Regarding claim 18, the Examiner states that Yuen discloses the method of applicant's invention substantially as claimed. Applicant respectfully traverses the Examiner's position, and points out to the Examiner that Yuen does not teach all of applicant's limitations as recited in claim 18.

The Examiner states that Yuen discloses initiating perpetual recording of the presented media, as recited in step (a) of applicant's claim 18. Applicant argues the Yuen does not teach initiating a perpetual recording of the presented media at all. Figure 1, and col. 12, lines 52-67 of Yuen describes an indexing videocassette recorder, using a hybrid indexing system that provides indexing of recorded programs contained in various types of tapes. The purpose of indexing VCR 10, as described in the portion of Yuen cited and applied by the Examiner, is for, just as the name implies, enabling sequential arrangement of recorded programs recorded on the various types of tapes, using a generated directory to perform searches of the user's tape library to find a tape containing a selected program. There is nothing whatsoever in the referenced portion of Yuen having anything having to do with initiating a perpetual recording of presented media, as is claimed in step (a) of applicant's claim 18.

Regarding step (b) of applicant's claim 18, the Examiner states that Yuen discloses identifying a specific media selection during media presentations. Col. 26, lines 60-67, and col. 33, line 54 to col. 34, line 67 of Yuen simply describes advancing the tape to the beginning of each program during the re-indexing process, or monitoring the VM packet in indexing the videotape. Applicant fails to see how the descriptions read on applicant's claimed step (b).

Regarding steps (c) - (e) of applicant's claim 18 Examiner states that Yuen discloses all of the limitations as recited by applicant's claim. Applicant has carefully reviewed all of the specific portions of Yuen cited and applied by the Examiner in support of the above statement, and it is clear to applicant that elements of the prior art have been taken out of context and have not been analyzed and applied by the Examiner for what they teach as a whole. In the portions cited Yuen discloses processes for indexing or re-indexing a tape, searching the tape for a selected program or identifying a recorded program, but nowhere deals with setting and initiating selected playback or permanent storage of media wherein activating a flag-set indicia from a user interface on the perpetual recording device enables playback or storing of the flagged media.

Regarding claim 20 to Examiner states that Yuen discloses that a flag set marks of applicant's claim 18, step (c) mark the beginning and end of the desired block of media. Col. 17, lines 51-55 of Yuen describes the indexing VCR 10, where upon reaching the start of program three, the indexing VCR 10 erases the VISS mark corresponding to the start of program three, and writes a new mark at the end of program five, which becomes the start of the remaining portion of program three. The marks described in Yuen are therefore beginning marks for program portions, not a flag-set marking the beginning and end of a desired block of media, as claimed.

Claim 1 is applicant's apparatus claim for practicing the claimed method of claim 18. The Examiner has rejected claims 1-4, 17 and 19 as unpatentable over Yuen/Official Notice. The Examiner states that, regarding claim 1, Yuen discloses all the features of the instant invention except for providing a speaker system, taking Official Notice that such an element is old and well-known in the art.

Applicant again points out to the Examiner that Yuen does not disclose a perpetual recording device, as recited in the preamble of claim 1, at all. Yuen

discloses a recording device (VCR 10) for indexing, or sequentially arranging programs of various tapes, not perpetually recording a program and setting and initiating selected playback or permanent storage of media wherein activating a flag-set indicia from a user interface on the perpetual recording device enables playback or storing of the flagged media. Applicant therefore argues that applicant's claim 1 is clearly and unarguably patentable over the art of Yuen, claims 2-4 and 17 being patentable on their own merits, or at least as dependent from a patentable claim.

Examiner has rejected claim 19 for the same reasons as for the above rejection of claim 3. Claim 19 is dependent upon applicant's method claim 18. In view of applicant's above arguments on behalf of method claim 18, applicant believes claim 19 is therefore patentable on his own merits, or at least as dependent from a patentable claim.

The Examiner has rejected claim 21 as unpatentable over Yuen in view of Ichinose (4,612,569). The Examiner states that Yuen discloses all the features of applicant's invention as discussed in claim 18, but does not specifically disclose wherein in step (d) the indicia is a jogging wheel manually operated to search the flag-sets, relying on Ichinose for disclosure of the claimed indicia.

In view of applicant's above arguments pertaining to claim 18, applicant believes that it has been clearly demonstrated that the reference of Yuen does not support a *prima facie* rejection, and is therefore not a proper primary reference for combining with Ichinose to read on applicant's claimed invention.

As all of the claims now standing for examination as argued have been shown to be patentable over the prior art, applicant respectfully requests that the rejections be withdrawn by the Examiner and that the present case be passed quickly to issue.

If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any

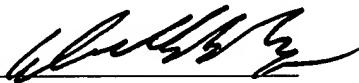
fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Versions With Markings to Show Changes Made

There are no amendments made in the present Amendment.

Respectfully Submitted,
Mark A. Boys

by



Donald R. Boys
Reg. No. 35,074

Donald R. Boys
Central Coast Patent Agency
P.O. Box 187
Aromas, CA 95004
(831) 726-1457